

**Amendments to the Drawings:**

The attached replacement drawing sheet include changes to the sole Figure, which has been amended to delete its labeling as "Fig. 1".

### **REMARKS**

Claims 19-31 were previously withdrawn from consideration. Claims 19-31 have been canceled. Claims 32-43 are currently pending, with claim 32 being the sole independent claim. The drawing has been amended. The specification has been amended. Claim 32 has been amended. Dependent claims 38-43 have been added. Support for the amendment to independent claim 32 may be found, for example, at pg. 4, lines 1-4 and at pg. 5, lines 7-11 of the specification as originally filed. Support for new dependent claims 38-43 may be found, for example, at pg. 5, lines 11-14 of the specification as originally filed. No new matter has been added. Reconsideration of the above-identified application, in view of the following amendment and remarks, is respectfully requested.

### **Information Disclosure Statement**

An Information Disclosure Statement (IDS) is being filed concurrently with the instant amendment. An acknowledgement of the receipt, entry and consideration of the IDS is respectfully requested.

### **Objection to the Drawing**

The Examiner has stated that "Where only a single view is used in an application to illustrate the claimed invention, it must **not** be numbered and the abbreviation 'FIG.' must **not** appear." In response to this objection to the drawings, applicants submit herewith a replacement sheet containing a single figure which has been amended in the required manner. In addition, the specification has been amended to delete the reference to the numeral 1. Entry of the replacement sheet is respectfully requested.

### Claim Objection

Claim 37 has been objected to based on a minor informality. In response to the Examiner's objection, applicants have amended claim 37 in the suggested manner. Withdrawal of the objection is therefore requested.

### Rejections Under 35 U.S.C. §103

Claims 32-37 stand rejected under 35 U.S.C. §103(a) as being unpatentable over JP 08-290543 ("*Katsumaru*") in view of U.S. Patent No. 6,631,677 ("*Fuhrmann*"). For the following reasons, reconsideration and withdrawal of these rejections are respectfully requested.

Independent claim 32 has been amended to recite, *inter alia*, "at least one printing device, installed inline with the at least one printing unit, and configured to individualize the static or unchanging image by adding at least one dynamic or changing image to the substrate, each the at least one printing device used to print at least one dynamic or changing image receiving a data stream containing data for the at least one dynamic or changing image and being used to print at least one functionality different from a functionality "color" for producing the static or unchanging image". The combination of the cited art fails to teach or suggest this limitation because *Katsumaru* and *Fuhrmann*, individually or in combination fails to teach or suggest the expressly recited subject matter of now amended independent claim 32.

The Examiner (at pg. 5 of the Final Office Action) has acknowledged that *Katsumaru* fails to teach or suggest "how the static or unchanging image is formed in the printing unit and whether the unit is configured to receive a data stream containing data for the static or unchanging image," as recited in independent claim 32, and cites *Fuhrmann* for this feature.

Applicants, however, respectfully disagree that the combination of *Katsumaru* and *Fuhrmann* teaches or suggests the expressly recited limitations of now amended independent claim 32.

*Katsumaru* relates to a method for printing “a newspaper having a partially different advertising page by providing an ink jet printing unit and further providing a section for forming a blank space where no printing is made on the web, on a part of a printing plate to be attached to the printing cylinder of a printing device” (see Abstract). *Katsumaru* fails to teach or suggest the expressly recited subject matter of now amended independent claim 32. According to *Katsumaru*, “an ink jet head 9 is activated to print the name of a car dealer controlling the region where the covers and newspaper carrying the advertisement is distributed” (see Constitution, lines 8-11). There is no teaching or suggestion in *Katsumaru* that the ink jet head prints anything other than a color function, i.e., ink. That is, *Katsumaru* fails to teach or suggest “the at least one printing device used to print at least one dynamic or changing image receiving a data stream containing data for the at least one dynamic or changing image and being used to print at least one functionality different from a functionality “color” for producing the static or unchanging image”, as recited in now amended independent claim 32.

As explained at paragraph [0013] of the Examiner-provided English translation of *Katsumaru*, the ink jet unit 9 is formed as a roller type, and is supported pivotally, enabling free rotation. *Katsumaru* (paragraph [0014]; Fig. 3) further explains that “the main part 9a with said cylinder ink jet head 9 and the slit shape ink ject 9c formed in the layer part in parallel with the pivot 9b outside the main part 9a ... comprises the ink jet nozzle 9d provided in the pars basilaris ossis occipitals (sic) of the ink slot 9c, the control electrode 9e laid under the wall surface of the ink jet 9c, the ink tank 9f, the ink pressurizer 9g, etc”. There is no teaching or suggestion whatsoever that the ink jet head 9 of *Katsumaru* is configured to print “at least one functionality different from a functionality “color” for producing the static or unchanging image that is printed by the printing”, as recited in now amended independent claim 32.

According to the Examiner, “printing units configured to receive data of the static or unchanging image and to perform in-press imaging of the print drum are well known in the art as exemplified by the press of Fuhrmann et al”. However, there is no teaching or suggestion whatsoever in *Fuhrmann* of the printing device of now amended independent claim 32.

*Fuhrmann* relates to a printing machine that is configured “to avoid mechanical inaccuracies that arise due to the transversal movement of the form cylinders or of the printing head or due to the pivotal movement of the imaging system as a whole” (see col. 1, lines 62-66).

As explained in *Fuhrmann*, “light diversion means are used to optionally divert the laser pulses generated by the laser unit to one of the two or more form cylinders” (see col. 2, lines 9-11). *Fuhrmann* (col. 2, lines 11-15) explains that “[t]he light diversion means are, for example, mirrors, prisms or optical waveguides, by means of which the laser pulse can be diverted in accordance with the curvature of the optical waveguides in any desired spatial direction”. Moreover, *Fuhrmann* describes an embodiment in which the “light diversion means ... can include a mirror, a prism, a system of image-forming lenses, a holographic screen or a rotary device for rotating an end of an optical wave guide directable to a surface to be printed”.

There is no teaching or suggestion in *Fuhrmann*, however, that a printing device is configured in the manner expressly recited in now amended independent claim 32. That is, “at least one printing device, installed inline with the at least one printing unit, and configured to individualize the static or unchanging image by adding at least one dynamic or changing image to the substrate, each the at least one printing device used to print at least one dynamic or changing image receiving a data stream containing data for the at least one dynamic or changing image and being used to print at least one functionality different from a functionality “color” for producing the static or unchanging image”. *Fuhrmann* thus fails to teach or suggest now amended independent claim 32.

Since *Katsumaru* fails to teach or suggest, “a printing device that is configured to print at least one functionality different from a functionality “color” for producing the static or unchanging image” and *Fuhrmann* fails to provide that which *Katsumaru* lacks, the combination of *Fuhrmann* and *Katsumaru* fails to achieve the device of now amended independent claim 32.

In view of the foregoing, independent claim 32 is patentable over the combination of *Katsumaru* and *Fuhrmann*. Reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a) is therefore in order, and a notice to that effect is respectfully requested.

In view of the patentability of independent claim 32, dependent claims 33-37, as well as new dependent claims 38-43, are also patentable over the prior art for the reasons set forth above, as well as for the additional recitations contained therein.

Based on the foregoing remarks, this application is in condition for allowance. Early passage of this case to issue is respectfully requested.

Should the Examiner have any comments, questions, suggestions, or objections, the Examiner is respectfully requested to telephone the undersigned in order to facilitate reaching a resolution of any outstanding issues.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,  
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